

**REMARKS**

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1, 3-8, 11-13 and 17-19 are pending in this application. Claims 1, 3, 8 and 19 are amended and claims 2, 9-10 and 14-16 have been cancelled. Claim 1 is the sole independent claim.

Applicants note with appreciation the Examiner's acknowledgement that certified copies of all priority documents have been received by the U.S.P.T.O. Action, summary at 12.

Applicants also respectfully note the present action indicates that the drawings have been accepted by the Examiner. Action, summary at 10.

**Claim Objections**

Claim 1 is objected to because the acronym "ES" is used without first identifying the cells by the complete name. Applicants have amended claim 1 to define "ES cells" as "embryonic stem cells". Therefore, withdrawal of the objection is respectfully requested.

**Rejections under 35 U.S.C. § 101**

Claims 8, 16 and 19 are rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter.

Claim 16 has been cancelled and so the rejection of claim 16 is now moot.

Applicants have amended claims 8 and 19 to recite an isolated lens cell. Thus, claims 8 and 19 are directed to statutory subject matter. Withdrawal of the rejections is respectfully requested.

**Example Embodiments of the Present Application**

A non-limiting example embodiment of a method of producing a lens cell is explained on page 10, lines 9-22 of the present specification. Washing is performed only once to desirably induce differentiation of the ES cell into a lens cell.

**Rejections under 35 U.S.C. § 102**

Claims 1-4, 6-9, 11 and 14-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kawasaki et al. *Generation of dopaminergic neurons and pigmented epithelial from primate ES cells by stromal cell-derived inducing activity*, Proceedings of the National Academy of Sciences USA 99(3):1580-1585, published on February 5, 2002 (hereinafter "Kawasaki"). Applicants respectfully traverse this rejection for the reasons detailed below.

Claims 2, 9 and 14-16 have been cancelled, so the rejection in regards to claims 2, 9 and 14-16 is now moot.

Independent claim 1 recites "a washing step, carried out between the ES cell maintenance step and the differentiation inducing step, of washing the maintained ES cell only once with an ES differentiation medium". Example non-limiting embodiments of this feature are discussed, for example, on page 10, lines 9-22 of the instant specification. Kawasaki, as relied upon by the Examiner, fails to anticipate or suggest a washing step, carried out between the ES cell maintenance step and the differentiation inducing step, of washing the maintained ES cell only once with an ES differentiation medium as disclosed in independent claim 1.

Page 1581, column 1, lines 8-10 of Kawasaki teach undifferentiated ES cell colonies that were washed twice with differentiation medium. Therefore, Kawasaki, as relied upon by the Examiner, fails to anticipate or suggest a washing step, carried out between the ES cell

maintenance step and the differentiation inducing step, of washing the maintained ES cell only once with an ES differentiation medium as recited in independent claim 1.

The Applicants, therefore, respectfully request that the rejection to Claim 1 under 35 U.S.C. § 102(b) be withdrawn.

Claims 2-4, 6-9, 11 and 14-19, dependent on independent claim 1, are patentable for the reasons stated above with respect to claim 1 as well as for their own merits.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection to independent claim 1 and all claims dependent thereon.

### **CONCLUSION**

In view of the above remarks and amendments, the Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

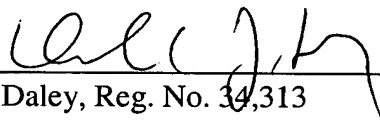
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Erin G. Hoffman, Reg. No. 57,752, at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKY, & PIERCE, P.L.C.

By

  
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